



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/824,028

04/13/2004

Stephen Byng

7051P001

6043

23446 7590 02/19/2009
MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER

YOO, JASSON H

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

02/19/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/824,028	Applicant(s) BYNG, STEPHEN	
	Examiner Jasson H. Yoo	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 64-83 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 64-83 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 64-83 recite the claim limitations of, "enroll", "un-enroll" and "cooperative gaming group". However, the specification does not clearly define these terms. Applicant is advised to amend the claim to use terminology that is consistent with the specifications.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 64-73 are rejected under 35 USC 101 as being directed to non-statutory subject matter because these are method or process claims that do not transform underlying subject matter (such as an article or materials) to a different state or thing, nor are they tied to another statutory class (such as a particular machine). See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (quoting *Benson*, 409 U.S. at 70); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978) (citing *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). See also *In re Comiskey*, 499 F.3d 1365, 1376 (Fed. Cir. 2007) (request for rehearing *en banc* pending). Claims 64-73 are directed to a method of establishing a cooperative game and allowing a player to enroll or un-enroll from the cooperative game. Although independent claim 64 incorporates "a method for use with a gaming

Art Unit: 3714

system" in the preamble of the claim, the claim does not describe how the method of establishing a cooperative game and allowing a player to enroll or un-enroll from the cooperative game is actually tied to the gaming system.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 64-83 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim limitations of "allowing a person to enroll in a cooperative gaming group" and "allowing the person to "un-enroll from the cooperative gaming group" are not described in the specification. Applicant specification (paragraph 65) discloses that the player can register their interest to a cooperative gaming environment. This description indicates that the player registers to play in a cooperative gaming **environment**. However, there is no descriptions that teaches or suggests that a player is allowed **enroll in a gaming group**. Furthermore, Applicant specification (paragraph 31 and 84) discloses that the player may choose to exit the cooperative gaming environment. This limitation indicates that the player can

Art Unit: 3714

quit the cooperative gaming **environment**. However, there is no descriptions that teaches or suggests that a player is allowed to **un-enroll from the gaming group**.

Furthermore, the description cited in attempt to provide support for the claim limitation of “enroll”, appears to refer to enlisting or registering to the gaming environment (Paragraph 65). However, the description cited in attempt to provide support for the claim limitation of “un-enroll” (paragraphs 31, 38), appears to refer to quitting the gaming environment; instead of “delisting” or “un-registering”. Thus the definition of the terms “enroll” and “un-enroll” are inconsistent with each other.

Claims 73 and 78 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claims 64 and 74 are directed to a method and a gaming machine configured to allow a person enrolls in a cooperative gaming group. Applicant’s specification (paragraph 64) discloses that a message is displayed to the player in order to allow a player participate in the cooperative gaming environment. Claims 73 and 78 (dependent on claims 64 and 74) incorporate the limitation of allowing the person to indicate that the person does not wish to be presented with the message. Although Applicant’s specification discloses that the person can turn off the reception of the messages (paragraph 70), Applicant’s

Art Unit: 3714

specification fails to disclose how the player can be invited to participate in a cooperative gaming group when the message reception is turned off.

Claims 73 and 78 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As discussed above, Applicant's specification fails to disclose how the player can be invited to participate in a cooperative gaming group when the message reception is turned off.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 70 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 70 recites the limitation "with at least one rule". There is insufficient antecedent basis for this limitation in the claim. More specifically, it is not clear if "with at least one rule" refers to the at least one rule in claim 64, or refers to a different at least one rule.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 64-72, 74-77, 79-83 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al (US 2003/0064807).

Claims 64, 74. Walker discloses a method and gaming system (Fig. 3) configured to provide linked play via gaming and other devices. The linked play allows players to enroll in a cooperative gaming group (play in a group, paragraph 30) with at least on input interface of a gaming machine (Walker discloses an input device 312 in Fig. 3. 400. The input device can be a touch-screen as illustrated in Figs. 4-5 and disclosed in paragraph 49.). The gaming system is configured to establish at least one rule the cooperative game (Fig. 5). These rules are known as group format and group objective (paragraphs 32, 57-58) and can be established by the person or group members (paragraph 144-145). The rules are presented to the person with at least one visual display (For example, Fig. 4, paragraphs 126-130). Furthermore, the rules can be presented to the player when the player establishes the rules (Fig. 5). Walker further discloses the person can un-enroll from the cooperative gaming group subsequent to the presenting the at least one rule to the person using at the at least one input

interface. The term "un-enroll" can be interpreted as declining to play the game.

Walker discloses this in Fig. 4. Additionally, the term "un-enroll" from the gaming group can be interpreted as quitting the gaming group. Walker discloses that players can un-enroll or quit the gaming group (paragraphs 253--259).

Claims 65, 75. Walker discloses at least a minimum number of persons enrolled in the cooperative gaming group (paragraph 229); and allowing the cooperative game to commence if it is determined that the minimum number of persons are enrolled in the cooperative gaming group (paragraph 229, s3 in Fig. 12).

Claims 66, 76. Walker discloses prompting the person to provide rule information; and establishing the at least one rule based on the rule information (i.e. Fig. 5, paragraphs 123, 144-145).

Claims 67, 77. Walker discloses allowing the person to specify how much the person wishes to wager during play of the cooperative game play (paragraph 67, discloses specifying the wager amount as a group format).

Claims 68, 79. Walker discloses establishing at least one rule occurring following the person to enroll [It is interpreted that the player enrolls when the player's gaming system is configured to play in the cooperative game. Thus as shown in Fig. 4, the rules are established after the person is enrolled.].

Claims 69, 80. Walker discloses allowing the person to un-enroll from the cooperative gaming group occurs following the presenting of the at least one rule [Walker discloses the player can “un-enroll” from the gaming group when the player quits in the middle of the cooperative gaming group session (paragraphs 253--259). Thus the person is allowed to un-enroll following the presenting of the least one rule (in order to quit in the middle of the session after the rules are presented to start the session).].

Claims 70, 81. Walker discloses providing the person with at least one rule prior to the allowing of the person to enroll [The term enroll is interpreted as playing or accepting to play in the cooperative gaming session. Thus as shown in Fig. 4, the rules are provided prior to the person enrolling.].

Claims 71, 82. Walker discloses establishing of at least one rule includes changing the at least one rule (Rules can include changes of the rules, i.e. when a group member leaves, paragraph 57. Furthermore, the rules can be changed by selecting the desired rules, Fig. 5.).

Claims 72, 83. Allowing the cooperative gaming group to play a cooperative game, wherein the presenting of the at least one rule occur during the cooperative game (The cooperative game can be considered to start when the player decides to

Art Unit: 3714

play. Thus, Figs. 4 and 5 disclose the rules are displayed during the cooperative game. Furthermore, player may join the game during the cooperative game (paragraphs 132, 133, 229). When a new member joins the group during the cooperative game, the rules are presented to the new member (paragraphs 126-130).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 73, 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker'807 et al (US 2003/0064807) as applied to claims 64, and 74 above, and further in view of Walker'893 (et al. (US 6,186,893)

Claims 73, 78. Walker'807 discloses the method of establishing at least one rule for a cooperative game and allowing a person to enroll and un-enroll from the cooperative gaming group as discussed above. Walker'807 further discloses that the person is informed to enroll in the cooperative gaming group with a message (Fig. 4). However, Walker fails to teach that the person is allowed to indicate that the person does not wish to be presented with the message. Nevertheless, such modifications would have been obvious to one of ordinary skill in the art. In an analogous art to methods of playing games and providing messages, Walker'893 discloses a method of

Art Unit: 3714

providing messages to player on the gaming machine (col. 6:3-6). Walker'893 also discloses the messages can be disabled (col. 6:6-8). This option provides players privacy by allowing players to focus on their own individual games without interruptions. Therefore it would have been obvious to one of ordinary skilled in the art the time the invention was made to modify Walker'807 of providing a message to enroll in a cooperative game and incorporate Walker'893's method of disabling the message, in order to provide players privacy by allowing players focus on their own individual games without interruptions.

Response to Arguments

Applicant's arguments with respect to claims 64-83 have been considered but are moot in view of the new ground(s) of rejection. New grounds of rejection have been made using Walker to address the newly presented claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 3714

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasson H. Yoo whose telephone number is (571)272-5563. The examiner can normally be reached on 9:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JHY

Application/Control Number: 10/824,028

Page 12

Art Unit: 3714

/Peter D. Vo/

Supervisory Patent Examiner, Art Unit 3714